

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex Parte Clifford Lee Hannel et al.

U.S. PATENT APPLICATION NUMBER 10/019,101

FILING DATE: DECEMBER 20, 2001

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

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A *Notification of Non-Compliant Appeal Brief* was issued on April 22, 2009. In that *Notification*, it was asserted that the Appeal Brief filed on March 24, 2009 was defective for failure to comply with 37 C.F.R. § 41.37(c)(1)(iii) and (vi). Specifically, the *Notification* asserts that the “The Appeal Brief fails to provide the status of all the claims in the application” and that the “The “Grounds of Rejection” must be consistent with the grounds of rejection listed in the last office action. Each Grounds of Rejection to be reviewed on appeal must be identified.”

The Appellants note that 37 C.F.R. § 41.37(c)(1)(vi) merely requires “[a] concise statement of each ground of rejection presented for review.” As such, the C.F.R. does not require that the grounds for rejection be listed as set forth in the examiner’s final office action. In the interest of progressing the present appeal toward resolution, however, counsel for the Appellants submit the attached revised appeal brief with revised sections entitled “Status of the Claims” including the status of cancelled claims in accordance with 37 C.F.R. § 41.37(c)(1)(iii), “Grounds of Rejection to be Reviewed on Appeal” and “Argument” listing rejections as set forth in the final office action in accordance with 37 C.F.R. § 41.37(c)(1)(vi) and (vii). It is not believed that resubmission of a complete new brief is required in that “[t]he examiner should not require a corrected brief for minor non-compliance.” MPEP § 1205.03.

Respectfully submitted,
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STATUS OF THE CLAIMS
(37 C.F.R. § 41.37(c)(1)(iii))

Claims 1-3 and 5-10 are presented for appeal. Claims 4 and 11-14 have been cancelled. The claims presented for appeal have been at least twice rejected. No claims have been allowed or are otherwise objected to by the Examiner.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL
(37 C.F.R. § 41.37(c)(1)(vi))

- I. Do U.S. patent numbers 5,634,053 to Nobel et al. and 7,212,262 to Elley et al. in view of U.S. patent number 5,115,501 to Kerr render claims 1-3 and 5-10 obvious under 35 U.S.C. § 103(a)?
 - (A) Is there a motivation to combine Nobel et al., Elley et al. and Kerr in an attempt to establish the purported obviousness of the Appellants' claimed invention?
 - (B) Did the Examiner misapply the Supreme Court's Holding in KSR International and the Board of Patent Appeals and Interferences Holding in Ex Parte Smith?

ARGUMENT
(37 C.F.R. § 41.37(c)(1)(vii))

- I. **U.S. PATENT NUMBERS 5,634,053 TO NOBEL ET AL. AND 7,212,262 TO ELLEY ET AL. IN VIEW OF U.S. PATENT NUMBER 5,115,501 TO KERR DO NOT RENDER CLAIMS 1-3 AND 5-10 OBVIOUS UNDER 35 U.S.C. § 103(A).**
 - (A) **THERE IS NO MOTIVATION TO COMBINE NOBEL ET AL., ELLEY ET AL. AND KERR.**

The Examiner contends that the combination of Noble et al., Elley et al., and Kerr discloses the subject matter of what was previously pending claims 1, 4, and 14. See *Office Action VII*, 3-5 and 9-10. The subject matter of those claims has since been incorporated into independent claim 1. See *Response G*, 5. The Appellants contend that one skilled in the art would not have been motivated to make the Examiner's proposed combination, especially with respect to the Kerr reference.

Kerr concerns a purported "application program [that] automatically creates and presents a customized user interface." *Kerr*, Abstract. Kerr purports to create and present this interface by "determining a set of operations which is appropriate for the current user based on various relevant characteristics of the user." *Id.* As a result, "[t]he application program presents only the specified operations in the menus, icons, application bars or other interface components of the application program."

As an initial matter, the Appellants contend that one skilled in the art would not seek to combine the teachings of user interface creation and generation (Kerr) in the context of the credential and membership disclose of Elley et al., and the smart dictionaries, data information managers, and local information managers referenced in Noble et al. There simply is no reason to make this combination; the Examiner's rejection (as discussed below) also fails to provide such a motivation. The Appellants further question whether one would make the aforementioned use of the UI teachings of Kerr in an effort to arrive

at the presently claimed ‘apparatus for providing information in response to a query of a virtual database table’ as set forth in claim 1.

When applying 35 U.S.C. 103(a), the following tenets of patent law must be adhered to: (A) The claimed invention must be **considered as a whole**; (B) The **references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination**; (C) The references must be viewed without the benefit of **impermissible hindsight** vision afforded by the claimed invention; and (D) Reasonable expectation of success is the standard with which obviousness is determined. See *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). The Appellants respectfully suggest that the references and the presently claimed invention have not been considered as a whole, especially in light of the aforementioned combination of references. In that regard, the Appellants respectfully contend that a *prima facie* case of obviousness has not been made and that the rejection is overcome.

Notwithstanding, the Examiner contends that “[i]t would have been obvious to one of ordinary skill in the art . . . to modify the above combination” to include “an additional information source that is a user profile information source,” wherein “the manner of selecting [a] row includes profile gathering information,” and “the provided information is obtained at least in part from the profile information source.” *Office Action VII*, 9-10; see also *Office Action VIII*, 4-5. The Examiner’s motivation, however, is nothing more than a summary of the claimed subject matter of former dependent claim 14 (now a part of independent claim 1). The Appellants challenge the purported motivation to combine in that the Examiner has failed to identify any teaching in any reference or any evidence that is actually known or would be known to one of ordinary skill in the art as to why one would make the purported combination as presented by the Examiner.

As an initial matter, the Appellants appreciate that “[t]he rationale to modify or combine the prior art does not have to be expressly stated in the prior art” and that “the rationale

. . . may be reasoned from knowledge generally available to one of ordinary skill in the art.” *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). That said, a mere conclusory statement that modifications of the prior art to meet the claimed invention would have been well within the ordinary skill of the art “because the references relied upon teach that all aspects of the claimed invention were individually known in the art is **not sufficient** to establish a *prima facie* case of obviousness without some **objective reason to combine** the teachings of the references.” *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (emphasis added). The Supreme Court re-affirmed the same in *KSR International Co. v. Teleflex Inc.* wherein the court found that “rejections on obviousness cannot be sustained by **mere conclusory statements**; instead, there must be some **articulated reasoning** with some **rational underpinning** to support the legal conclusion of obviousness.” 550 USPQ2d 1385, 1396 (2007) (emphasis added); see also *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Absent such objective articulated reasoning and some rational underpinning related to the same, the Appellants contend that a *prima facie* case of obviousness has not been and that the Examiner’s rejection is overcome.

(B) THE EXAMINER HAS MISAPPLIED THE SUPREME COURT’S HOLDING IN KSR INTERNATIONAL AND THE BOARD OF PATENT APPEALS AND INTERFERENCES HOLDING IN EX PARTE SMITH.

The Examiner—in the final rejection in the prosecution of the ‘101 Application—countered the Appellants’ arguments concerning a lack of motivation to combine with the following:

If [the] applicant argues that there is no specific suggestion or teaching in the references to combine prior art, the examiner may respond that KSR forecloses the argument that a specific teaching, suggestion or motivation is required to support a finding of obviousness.

Office Action VIII, 9 (citing *Ex Parte Smith*, slip. op. 20).

The Examiner overextends the Supreme Court's holding in *KSR* as well as that of the Board in *Ex Parte Smith*. *KSR* does not suddenly create a 'get out of jail free' card whereby an Examiner may counter any argument concerning motivation to combine with a conclusory response that '*KSR* forecloses the need for any specific teaching, suggestion, or motivation.' The current version of the Manual of Patent Examining Procedure (MPEP), which takes into account the Supreme Court's holding in *KSR*, indicates the same as it states:

Obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention **where there is some teaching, suggestion, or motivation to do so.** *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006).

MPEP § 2143.01(I) (emphasis added).

The MPEP continues—and directly references *KSR*—in noting that:

The mere fact that references **can** be combined or modified does not render the resultant combination obvious **unless the results would have been predictable to one of ordinary skill in the art.** *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007).

MPEP § 2143.01(III) (emphasis added).

The Supreme Court, in its *KSR* decision, specifically stated that "[h]elpful insights [like TSM] . . . need not become rigid and mandatory formulas" for when such rigid application occurs, "the TSM test is incompatible with our precedents." *KSR*, slip. op. 15. The Appellants are mindful of the Court's holding in *KSR*. In light of the same, the Appellants are not suggesting—nor have they ever intended to—that a strict application of the teaching, suggestion, motivation test must be applied in order to support a *prima facie* case of obviousness. Such a request would be improper under *KSR* as well as *Ex Parte Smith* where the Board—correctly—found that "*KSR* forecloses Appellant's argument that **a specific teaching** is required for a finding of obviousness." *Ex Parte Smith*, Slip. Op. 20 (citing *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396). This does not

mean, however, that the Examiner is freed from the obligation to evidence **some** motivation to combine in order to establish a *prima facie* case of obviousness.

Notwithstanding the misinterpretation of *Ex Parte Smith*, the Board's decision is illustrative of an Examiner's ongoing obligation to evidence motivation to combine. The Board—in affirming a finding of obviousness in the context of *KSR*—found that “[a] person of ordinary skill is also a person of ordinary creativity, not an automaton.” *Ex Parte Smith*, slip. op. 20, (quoting *KSR*, 127 S.Ct. at 1742). “It would,” found the Board, “take no more than ordinary creativity for a person of ordinary skill to [arrive at the claimed invention at issue in *Ex Parte Smith*.]” *Ex Parte Smith*, slip op. 20. *Ex Parte Smith* was not about foreclosure of any counter to obviousness, but rather reaffirmed that an argument advanced by the Examiner regarding some motivation to combine must occur in the context of a properly founded rejection.

For example, *Ex Parte Smith* stated that the Examiner's combination was proper because “[c]ommon sense teaches . . . that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *Ex Parte Smith*, Slip Op. 20 (quoting *KSR*, 127 S.Ct. at 1742, 82 USPQ2d at 1397). The Examiner's rejection in the present appeal, however, does not even provide this limited context as to why a motivation to combine exists, but rather based on impermissible hindsight. The Examiner's argument is, at best, circular in that it contends it would be obvious to utilize the Kerr reference because the Kerr reference purportedly discloses that which is claimed by the Appellants.

KSR requires that an obviousness rejection set forth more than mere conclusory statements. See *KSR*, 550 USPQ 2d 1385. “[T]here must be some **articulated reasoning** with some **rational underpinning** to support the legal conclusion of obviousness.” *Id.* (emphasis added). A *prima facie* case of obviousness cannot survive absent “some

objective reason to combine the teachings of the references.” *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (emphasis added).